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EXAMINER

GARG, YOGESH C

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANANDAKUMAR VARATHARAJAH

Appeal 2008-4557
Application 09/663,069
Technology Center 3600

Decided:¹ May 18, 2009

Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and
ANTON W. FETTING, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

Anandakumar Varatharajah (Appellant) seeks our review under 35 U.S.C. § 134 of the final rejection of claims 1, 2, 5-10, and 12-19. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We REVERSE.²

THE INVENTION

The invention “relates to electronic-transaction records, depositories for such records and the use of such records in subsequent electronic transactions.” (Specification 2:8-10.)

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A method for manipulating receipt data, the method comprising:

receiving, on a user computing device, a user selection of a first line item from a first electronic receipt stored on a remotely located data farm, thereby forming an electronic list, wherein the first electronic receipt includes a record of a first purchase transaction;

transmitting the selection to the data farm;

storing the list on the data farm after the selection is made; and

² Our decision will make reference to the Appellant’s Appeal Brief (“App. Br.,” filed Nov. 5, 2007) and Reply Brief (“Reply Br.,” filed Mar. 25, 2008), and the Examiner’s Answer (“Answer,” mailed Dec. 20, 2007).

receiving a user authorization for a group of people to remotely review the list, the reviewing performed using at least one remote computing device.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Ogasawara	US 6,327,576 B1	Dec. 4, 2001
Kraemer	US 6,490,602 B1	Dec. 3, 2002
Brinkerhoff	US 6,963,848 B1	Nov. 8, 2005

End-to-End Enterprise Solution: Extending the Reach of Retail Stores Through Point-of-Sales Web Technology,
<http://java.sun.com/features/1999/12/atpos.html> (last visited Mar. 5, 2005) (hereinafter “the Article.”)

The following rejections are before us for review:

1. Claims 1, 2, 5, 7-10, 12, and 14-19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kraemer and Ogasawara.
2. Claim 6 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Kraemer, Ogasawara, and Brinkerhoff.
3. Claim 13 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Kraemer, Ogasawara, and “the Article.”

ARGUMENTS

Independent Claim 1 and Its Dependent Claims

The Examiner contends that Kraemer discloses all of the steps of claim 1 except for using electronic receipts for preparing an electronic list. (Answer 5.) The Examiner states “[t]he examiner interprets ‘electronic

receipt stored on a remotely located data farm['] as digital data stored on a remote web site” and contends that this stored digital data could relate to a record of a previous purchase transaction as claimed or a list of vendor items displayed on a web page as taught in Kraemer. (Answer 10.) However, the Examiner then contends that Ogasawara describes electronic receipts (Answer 11) and concludes

[t]herefore, it is obvious from Ogasawara’s teachings that the historical data stored in electronic receipts from previous purchase transactions can be used for future shopping activities including creating gift registries because the purpose of [a] gift registry is to prepare a shopping list for products from various stores as taught in Kraemer.

Id.

The Appellant argues that one of ordinary skill in the art would not have been led by Kraemer and Ogasawara to the claimed step of receiving a user selection of a first line item from a first electronic receipt stored on a remotely located data farm since 1) Kraemer does not describe an electronic receipt as the term “electronic receipt” is understood in the art to be digital data regarding previous purchases or transactions (Reply Br. 5), and 2) one of ordinary skill in the art would not be led to add the electronic receipts of Ogasawara to Kraemer as contended by the Examiner since a user forming a gift registry would have no desire to register for gifts that he or she has already selected or purchased. *Id.*

Independent Claims 9, 16, and 18 and Their Dependent Claims

The Appellant argues that the same arguments as discussed in regards to claim 1, apply to claims 9, 16, and 18 and their dependent claims. (App.

Br. 8-9.) The Examiner also responds that the rejection should be sustained for the same reasons as put forth for claim 1. (Answer 13-14.)

Dependent Claim 6

The Appellant argues that the addition of Brinkerhoff does not cure the deficiencies of the combination of Kraemer and Ogaswara that were argued with respect to claim 1. (App. Br. 10.) The Examiner responds that the rejection should be sustained for the same reasons as put forth for claim 1. (Answer 14.)

Dependent Claim 13

The Appellant argues that the addition of “the Article” does not cure the deficiencies of the combination of Kraemer and Ogaswara that were argued with respect to claim 1. (App. Br. 11.) The Examiner again responds that the rejection should be sustained for the same reasons as put forth for claim 1. (Answer 14.)

ISSUES

The first issue before us is whether the Appellant has shown that the Examiner erred in rejecting claims 1, 2, 5, 7-8, and 14-15 under 35 U.S.C. § 103(a) as being unpatentable over Kraemer and Ogasawara. Specifically, what is the ordinary and customary meaning of “electronic receipt” and would one of ordinary skill in the art have been led by Kraemer and Ogasawara to a method including the claimed step of receiving a user selection of a first line item from a first electronic receipt stored on a remotely located data farm. The rejection of claim 6 also turns on this issue.

The second issue before us is whether the Appellant has shown that the Examiner erred in rejecting claims 9-10 and 12 under 35 U.S.C. § 103(a) as being unpatentable over Kraemer and Ogasawara. Specifically, what is the ordinary and customary meaning of “electronic receipt” and would one of ordinary skill in the art have been led by Kraemer and Ogasawara to a method including the claimed steps of generating an electronic receipt and storing the electronic receipt in a remote database. The rejection of claim 13 also turns on this issue.

The third issue before us is whether the Appellant has shown that the Examiner erred in rejecting claims 16-17 under 35 U.S.C. § 103(a) as being unpatentable over Kraemer and Ogasawara. Specifically, what is the ordinary and customary meaning of “electronic receipt” and would one of ordinary skill in the art have been led by Kraemer and Ogasawara to an apparatus including a shopping service stored in a second computing device coupled to the data farm and configured to retrieve the electronic receipt from a consumer and allow the consumer to remotely select a line item from the transaction record, thereby creating a review list stored on the data farm after the selection is made.

The fourth issue before us is whether the Appellant has shown that the Examiner erred in rejecting claims 18-19 under 35 U.S.C. § 103(a) as being unpatentable over Kraemer and Ogasawara. Specifically, what is the ordinary and customary meaning of “electronic receipt” and would one of ordinary skill in the art have been led by Kraemer and Ogasawara to an article containing instructions to select a first line item from a first electronic receipt, wherein the first electronic receipt includes a record of a purchase

transaction and store the selected first line item in a remote storage location after the selection is made, to form a list.

FINDINGS OF FACT

We find that the following enumerated findings of fact (FF) are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

Claim construction

1. Claim 1 recites a method including “receiving, on a user computing device, a user selection of a first line item from a first electronic receipt stored on a remotely located data farm, thereby forming an electronic list, wherein the first electronic receipt includes a record of a first purchase transaction.”
2. Claim 9 recites “generating an electronic receipt for the transaction, the receipt including a line item corresponding to a purchase record for each of the first and second goods.”
3. Claim 9 also recites
storing the electronic receipt in a remote database for later retrieval, wherein the user may select the line items using the user computing device and then store the selection in the remote database, thereby authorizing a group of user to retrieve the line items, the retrieval performed using at least one remote computing device.
4. Claim 16 recites a system including
a shopping service stored in a second computing device coupled to the data farm and configured to retrieve the electronic receipt for a consumer and

allow the consumer to remotely select a line item from the transaction record, thereby creating a review list stored on the data farm after the selection is made.

5. Claim 18 recites a computer program product including instructions to “select a first line item from a first electronic receipt, wherein the first electronic receipt includes a record of a purchase transaction.”
6. Claim 18 also recites that the computer program product includes instructions to “store the selected first line item in a remote storage location after the selection is made, to form a list.”
7. The Specification does not provide a definition for “receipt.”
8. A definition of “receipt” is “[a] written acknowledgment that a specified article, sum or money, or delivery of merchandise has been received.” (*See Webster’s II New Riverside University Dictionary* 981 (1984) (Entry for “receipt.”))

The scope and content of the prior art

Kraemer

9. Kraemer describes a method and apparatus for allowing a user to create a gift registry and purchase gifts from multiple retailers. (Col. 1, ll. 9-13.)
10. Kraemer describes using an enhanced functionality server 100 to create the gift registry in Example 1. (Col. 5, ll. 15-19.)
11. Kraemer describes a gift recipient accessing the enhanced functionality server to browse vendor and product pages. (Col. 5, ll. 26-28.)

12. Kraemer describes presenting a list of suggested or preferred retailers in response to the gift recipient's previous selections as well as being able to access unlisted retailers. (Col. 5, ll. 28-34.)
13. Kraemer describes the enhanced functionality server including a toolbar when presenting the vendor and product pages to the gift recipient. (Col. 5, ll. 53-56.)
14. Kraemer describes the toolbar having a "Register this gift" button. (Col. 5, ll. 56-58.)
15. Kraemer describes adding a product to a list in an account associated with the gift recipient when the "Register this gift" button is selected. (Col. 6, ll. 4-8.)
16. Kraemer states,

Enhanced functionality server 100 may use a series of question and answer forms to obtain information about the gift-giver, such as name and credit card information, and to make sure the gift-giver accesses the proper gift-recipient's gift registry. Having positively identified and supplied the correct authentication, the gift-giver may be presented with a series of screens, the total of which displays the gift-recipient's list of registered gifts.

(Col. 6, ll. 36-44.)
17. Kraemer also describes Example 3 as using the invention to devise a multi-retailer shopping cart where a user can purchase products from multiple retailers all at once. (Col. 7, ll. 35-43.)

Ogasawara

18. Ogasawara describes an inventory control system for managing expiration-dated products. (Col. 1, ll. 6-9.)
19. Ogasawara describes creating an electronic receipt when each item is scanned for purchase at checkout. (Col. 3, ll. 56-61.)
20. Ogasawara describes the electronic receipt including expiration-date information for each product. (Col. 3, ll. 47-53.)
21. Ogasawara describes an embodiment where the electronic receipt is stored on a store's server. (Col. 9, ll. 22-25.)
22. Ogasawara describes the customer retrieving the electronic receipt from a home terminal 24. (Col. 4, ll. 40-45.)
23. Ogasawara describes the items on the retrieved electronic receipt being added or appended to an inventory list. (Col. 11, ll. 4-7.)

Any differences between the claimed subject matter and the prior art

24. Kraemer does not describe electronic receipts, including a record of a purchase transaction.
25. Kraemer does not describe a shopping service configured to retrieve an electronic receipt and to allow a consumer to remotely select a line item from the transaction record.
26. Kraemer does not describe a computer program product including instructions to select a first line item from a first electronic receipt.
27. Kraemer does not describe using a record of past purchases to create the gift registry.
28. Ogasawara does not describe a user selecting a line item from the electronic receipt.

29. Ogasawara does not describe a shopping service configured to allow a consumer to remotely select a line item from the transaction record.
30. Ogaswara does not describe using the electronic receipt to create a shopping list.

The level of skill in the art

31. Neither the Examiner nor the Appellant has addressed the level of ordinary skill in the pertinent art of electronic commerce. We will therefore consider the cited prior art as representative of the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate level and a need for testimony is not shown’”) (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985)).

Secondary considerations

32. There is no evidence on record of secondary considerations of non-obviousness for our consideration.

PRINCIPLES OF LAW

Claim Construction

During examination of a patent application, a pending claim is given the broadest reasonable construction consistent with the specification and should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

[W]e look to the specification to see if it provides a definition for claim terms, but otherwise apply a broad interpretation. As this court has discussed, this methodology produces claims with only justifiable breadth. *In re Yamamoto*, 740 F.2d 1569, 1571 (Fed. Cir. 1984). Further, as applicants may amend claims to narrow their scope, a broad construction during prosecution creates no unfairness to the applicant or patentee. *Am. Acad.*, 367 F.3d at 1364.

In re ICON Health and Fitness, Inc., 496 F.3d 1374, 1379 (Fed. Cir. 2007). Limitations appearing in the specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003).

Obviousness

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 550 U.S. 398 at 407 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”) The Court in *Graham* further

noted that evidence of secondary considerations “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” 383 U.S. at 17-18.

ANALYSIS

The rejection of claims 1, 2, 5, 7-10, 12, and 14-19 under 35 U.S.C. § 103(a) over Kraemer and Ogasawara.

Method Claims 1, 2, 5, 7, 8, 14, and 15

We begin by construing claim 1. “As in any other context in which the scope and meaning of the claims bears on the ultimate determination at hand, we must start by considering the issue of claim construction.” *In re Nuijten*, 500 F.3d 1346, 1352 (Fed. Cir. 2007). “[D]uring examination proceedings, claims are given their broadest reasonable interpretation consistent with the [S]pecification.” *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000). *See also In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969); *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d at 1364.

Claim 1 recites “receiving, on a user computing device, a user selection of a first line item from a first electronic receipt stored on a remotely located data farm, thereby forming an electronic list, wherein the first electronic receipt includes a record of a first purchase transaction.” (FF 1.) Contrary to the Examiner’s interpretations of an electronic receipt as any digital data, we find the broadest reasonable interpretation of “electronic receipt,” which is consistent with the Specification, to be an electronic acknowledgment that a specified article, sum or money, or delivery of merchandise has been received. (FF 7-8.) We construe claim 1 to require receiving, on a user computing device, a user selection of a first line item

from a first electronic acknowledgement that a specified article, sum of money or delivery of merchandise has been received, which is stored on a data farm and includes a record of a first purchase transaction.

We find that the product web pages of Kraemer cannot be considered the claimed electronic receipts which include a record of a first purchase transaction. The web pages do not include an acknowledgement that a specified article, sum of money or delivery of merchandise has been received nor do the web pages include a record of a first purchase transaction. (FF 11.)

While we do find that Ogasawara describes an electronic receipt (FF 19), we find that one of ordinary skill in the art would not have been led to combine Kraemer and Ogasawara. The Supreme Court emphasized that “the principles laid down in *Graham* reaffirmed the ‘functional approach’ of *Hotchkiss*, 11 How. 248.” *Id.* (citing *Graham*, 383 U.S. at 12), and reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR* at 416. The operative question in this “functional approach” is “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *KSR* at 417. Ogasawara describes the function of the electronic receipts as creating records in an inventory control system (FF 22-23) and does not describe using the electronic receipt to create a shopping list (FF 30). Kraemer describes a gift registry system which makes a list of products, which have yet to be purchased, from web pages. (FF 13-16.) While Kraemer does teach creating a suggested list of retailers based on past browsing selections by the gift recipient (FF 17), Kraemer does not describe

using records of past purchases to create the gift registry. (FF 27.) Neither reference teaches using a record of past purchases to create a new list. Therefore, we find that adding electronic receipts which are used for inventory information in Ogasawara to the gift registry system of Kraemer is more than the predictable use of this element according to its established function.

Therefore, we find that the Appellant has shown that the Examiner erred in rejecting claim 1. Accordingly, the rejection of claim 1 and its dependent claims 2, 5, 7, 8, 14, and 15 are reversed.

Method Claims 9, 10, and 12

Like claim 1, claim 9 recites an electronic receipt which includes purchase records. (FF 2.) Claim 9 recites a method including the steps of generating an electronic receipt for the transaction and storing the electronic receipt in a remote database. (FF 2-3.)

For the reasons discussed above with regard to claim 1, we hold that the Appellant has shown that the Examiner erred in rejecting claim 9. Accordingly, the rejection of claim 9 and its dependent claims 10 and 12 are reversed.

Apparatus Claims 16 and 17

Like claim 1, claim 16 also recites an electronic receipt which includes purchase records. (FF 4.) Claim 16 recites an apparatus which includes a shopping service configured to retrieve the electronic receipt for a consumer and allow the consumer to remotely select a line item from the transaction record. (FF 4.) For the reasons discussed above with regard to claim 1, we hold that the Appellant has shown that the Examiner erred in

rejecting claim 16. Accordingly, the rejection of claim 16 and its dependent claim 17 is reversed.

Article Claims 18 and 19

Claim 18 recites a computer program product including instruction to select a first line item from a first electronic receipt, wherein the first electronic receipt includes a record of a purchase transaction. (FF 5-6.) For the reasons discussed above with regard to claim 1, we hold that the Appellant has shown that the Examiner erred in rejecting claim 18. Accordingly, the rejection of claim 18 and its dependent claim 19 is reversed.

The rejection of claim 6 under 35 U.S.C. § 103(a) over Kraemer, Ogasawara, and Brinkerhoff.

Claim 6 is dependent on claim 2, which is dependent on claim 1, whose rejection we have reversed above. The Examiner has not provided any additional reasoning as to why one of ordinary skill in the art would have been led by Brinkerhoff to the limitation of claim 1 discussed above, other than contending that Kraemer and Ogasawara describe this limitation. For the same reasons as above, we reverse the rejection of claim 6.

The rejection of claim 13 under 35 U.S.C. § 103(a) over Kraemer, Ogasawara, and “the Article.”

Claim 13 is dependent on claim 10, which is dependent on claim 9, whose rejection we have reversed above. The Examiner has not provided any additional reasoning as to why one of ordinary skill in the art would have been led by Brinkerhoff to the limitation of claim 9 discussed above,

other than contending that Kraemer and Ogasawara describe this limitation.
For the same reasons as above, we reverse the rejection of claim 6.

CONCLUSIONS

We conclude that the Appellant has shown that the Examiner erred in rejecting claims 1, 2, 5, 7-10, 12, and 14-19 under 35 U.S.C. § 103(a) as unpatentable over Kraemer and Ogasawara, claim 6 under 35 U.S.C. § 103(a) as unpatentable over Kraemer, Ogasawara and Brinkerhoff, and claim 13 under 35 U.S.C. § 103(a) as unpatentable over Kraemer, Ogasawara, and “the Article.”

DECISION

The decision of the Examiner to reject claims 1, 2, 5-10, and 12-19 is reversed.

REVERSED

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